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PATENT
Customer No. 22,852
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Attilio Bragheri et al.) Group Art Unit: 3663
Application No.: 10/522,555) Examiner: Bolda, Eric L.
Filed: January 27, 2005) Confirmation No. 8609
For: MULTI-STAGE RAMAN AMPLIFIER)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

In the Election of Species Requirement mailed April 21, 2006, the Examiner required an election from among four species he associated with claims 20-38. Specifically, the Examiner alleged that the four species "lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. The species are as follows:

- Group IA, claims 20-23 and 27 drawn to a method associated with Fig. 1
- Group IB, claims 24-26, drawn to a method associated with Fig. 2
- Group IIA, claims 28-31, and 35-38 drawn to apparatus of Fig. 1
- Group IIB, claims 32-34, drawn to apparatus of Fig. 2" (Office Action, p. 2).

In response, Applicants respectfully traverse, and will provisionally elect after detailing the reasons for traversal.

First, the Examiner has improperly divided the species into groupings of *claims*. As the M.P.E.P. specifies: "Claims are definitions of inventions. *Claims are never species.* [...] *Species are always the specifically different embodiments.*" M.P.E.P. § 806.04(e), emphasis in

original. The Examiner has contravened this rule, by dividing species according to claims, and then assigning those species to a drawing in the application. The Examiner also improperly assigned those drawings to his groupings of species.

The Examiner has improperly divided Groups IA and IB between Figs. 1 and 2. That is, the Examiner has improperly assigned dependent claims 24-26 to "a method associated with Fig. 2" (Office Action, p. 2). The language of claims 24-26 instead finds support in the as-filed application under the description of Fig. 1. Support for the language of claims 24-26 may be found in the specification at, for example, p. 20, lines 2-3; p. 23, lines 2-4; and p. 23, line 11 to p. 24, line 9. This corresponds to the description of Fig. 1, beginning on p. 12 of the specification. The description of Fig. 2 does not begin until p. 25. Thus, claims 24-26 should be considered with base claim 20, in Group IA, as "drawn to a method associated with Fig. 1" (Office Action, p. 2).

Second, the Examiner has improperly divided Groups IA and IB. The M.P.E.P. specifies that:

[u]nity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (PCT Rule 6.4). M.P.E.P. § 1850(II), emphasis added.

Applicants submit that the Examiner's "Group IB" contains only dependent claims 24-26, each being dependent from base claim 20. The Examiner placed base claim 20 in "Group IA." Thus, claims 24-26 should be considered with base claim 20, in Group IA.

Third, the election set forth below is made with traverse because the Examiner has not properly applied the standard of unity of invention that governs this application. The Examiner

provides no justification for restricting the claims of Groups IA from Group IB or the claims of Group IIA from Group IIB.

As described above, Applicants respectfully traverse the restriction and election requirements. However, to be fully responsive, Applicants provisionally elect to prosecute Group IA, “drawn to a method associated with Fig. 1” (Office Action, p. 2), and submit that claims 20-27 are readable thereon.

Finally, if the Examiner chooses to maintain the election requirement, however, and should the elected species be found allowable, Applicants expect the Examiner to continue to examine the full scope of the claimed subject matter to the extent necessary to determine the full scope of the patentability thereof, *i.e.*, extending the search to the non-elected species, as is the duty of the Examiner according to M.P.E.P. § 803.02.

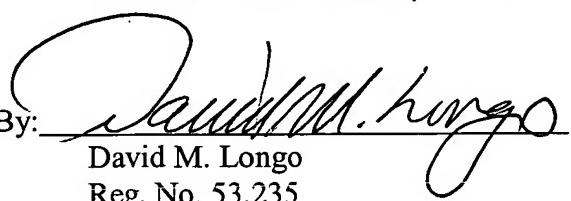
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 22, 2006

By:


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